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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,406	03/29/2006	Bernadette Verneau	065691-0397	3436
23428 7590 04/02/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER MI, QIUWEN	
			ART UNIT 1655	PAPER NUMBER
			MAIL DATE 04/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/542,406

Applicant(s)

VERNEAU, BERNADETTE

Examiner

QIUWEN MI

Art Unit

1655

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 14-34 is/are pending in the application.
- 4a) Of the above claim(s) 15, 16, 23 and 26-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 14, 17-22, 24, 25, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 7/15/05, 3/29/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group, claims 1, 14-27, 33, and 34, and species mono-di-or triglycerides, soya oil, and green tea in the reply filed on 2/11/08 is acknowledged. The traversal is on the ground(s) that the claims do possess unity of invention over the prior art, and searching for all the claims is not a burden. This is not found persuasive because as stated in the previous office action, since Wilson (US 5,466,459) teaches a wax and capsaicin based pesticide comprising 33% *Capsicum* extract, 9% paraffin wax (solid at room temperature), 2% mineral oil etc, therefore, there is no special technical feature in the application. Accordingly the groups are not so linked as to form a single general concept under PCT Rule 13.1., and therefore lack of unity of invention exists. Also, as indicated in the previous office action, the inventions of Groups I-II are two distinct inventions for the reason of the record. They have different electronic resources and search queries, and searching for one subject matter will not necessarily lead to another. Applicant is reminded of the extensive literature search in biotechnology which is not co-extensive.

The requirement is still deemed proper and is therefore made FINAL.

Claims Pending

Claims 1, and 14-34 are pending. Claims 15, 16, 23, and 26-32 are withdrawn as they are directed toward a non-elected invention groups or species. Claims 1, 14, 17-22, 24, 25, 33, and 34 are examined on the merits.

Specification/Abstract Objections

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the instant case, Applicant is required to delete "The invention concerns" on line 1 of the Abstract to be more clear and concise. The first letter of "a" in line 1 should be capitalized after the deletion. In addition, "said" on line 2 should be replaced.

Claim Objections

Claim 1 is objected to because of the following informalities: Claim 1 recites "a lipophilic additive which is solid or pasty at room temperature, the lipophilic additive which is solid or pasty at room temperature amounting to 5 to 20% by weight", and it is redundant to recite "solid or pasty at room temperature" twice in a claim.

Claim 22 is objected to because of the following informalities: Claim 22 recites "alga *Ascophyllum nodosum*" (line 3), which is incorrect, as the latin name of a plant should be italicized.

Appropriate correction is required.

Claim Rejections –35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 14, 17, 18, 24, 33, and 34 are rejected under 35 USC § 102 (b) as being anticipated by McClymont et al (GB 2367493 A).

McClymont et al teach a composition comprising 0.1-10% w/w of the capsicum oleoresin (a vegetable oil) (contains capsaicinoids), 0.15-15% w/w of the fatty acid triglyceride (a lipophilic additive, and a vegetable oil), etc (page 3, lines 7-15) for bird feed or deterrent to rodents (thus acceptable for oral administration). McClymont et al teach that the compositions are oil-in-water emulsions which have moderate phase stability and a large droplet size (thus pasty at room temperature).

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that the prior art product must not be precluded for use to stimulate thermogenesis. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims.

Therefore, the reference is deemed to anticipate the instant claim above.

Claim Rejections –35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 14, 17-22, 24, 25, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Mann (US 5,273,754), Mamana (US 2002/0192308), and Hosoya et al (JP 2001064672 A).

Mann teaches an appetite suppressant composition leading to a decrease in weight (col 1, lines 5-10) comprising a heating carminative substance, such as standard oleoresin capsicum which contains capsaicin (thus capsaicinoids) (thus in the form of capsicum resin) (col 2, lines 45-50), and a cooling carminative substance selected from peppermint, menthol, and spearmint etc (thus contains a vegetable oil) (claim 3; example 2). Mann also teaches that capsaicin is a preferred heating carminative substance, ...having a gastric heating effect exhibits a local anesthetic effect in the stomach (particularly upon the gastric nerves controlling hunger) when administered orally at a sufficient dose (col 2, lines 30-40). Mann further teaches that the appetite suppressant composition in a form suitable for oral administration, and preferably as a capsule (thus solid or pasty at room temperature) (col 4, lines 22-28).

Mann does not teach the incorporation of soya oil, and green tea into the composition, and neither does Mann teaches the claimed amount of the components.

Mamana teaches an appetite suppressant for controlling weight comprising green tea or green tea leaf extract (thus one or more physiologically active components) (claim 1). Mamana also teaches a method of controlling weight by replacing at least one meal with a soy based meal replacement (claim 22) (thus contains soya oil, a vegetable oil). Mamana further teaches that the appetite suppressant is preferably administered orally in the form of a capsule etc [0014].

Hosoya et al teach a fat metabolizer ingested (thus acceptable for oral administration) in very small amount comprising fats and oils consisting of diglyceride and/or monoglyceride (thus a lipophilic additive), linseed oil (thus a vegetable oil) etc. Hosoya et al also teach that the obtained fats and oils filled in a soft capsule. Hosoya et al teach that the results obtained showed that BMI, body fat rate and waist size were efficiently reduced without changing the eating habits of the persons (see Abstract, full translation has been ordered).

"It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose ...[T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted).

In the instant case, all of the above-listed ingredients were known for weight control. Thus, one of ordinary skill in the art would have had a reasonable expectation that the combination of these compounds would have been additively beneficial in weight control.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant ingredients for their known benefit since each is well known in the art for weight control. This rejection is based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients, *In re Sussman*, 1943 C.D. 518.

It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233; 235 (CCPA 1955). see MPEP § 2144.05 part II A. Although the prior art did not specifically disclose the amounts of each constituent as in the claims, it would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to determine all operable and optimal concentrations of components because concentration is an art-recognized result-effective variable which would have been routinely determined and optimized in the pharmaceutical art.

Accordingly, the instant claims, in the range of proportions where no unexpected results

are observed, would have been obvious to one of ordinary skill having the above cited references before him.

Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to combine the inventions of Mann, Mamana, and Hosoya et al since all of them teach compositions for weight control individually in the art. Since all the compositions yielded beneficial results in weight control, one of ordinary skill in the art would have been motivated to make the modifications. Regarding the limitation to the amount of the components in the composition, the result-effective adjustment in conventional working parameters is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan, which is dependent on the body weight, age, and appetite of the patient that is needed.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Conclusion

-----No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Qiuwen Mi

/Terry A. McKelvey/
Supervisory Patent Examiner, Art Unit 1655